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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/1G342-US1	7566
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LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,232

Applicant(s)

TENENBAUM, SAMUEL SERGIO

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005 and 04 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 and 58-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 and 58-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 5/2/05 and 11/04/05. Applicant's response filed 11/14/05 is persuasive at least in part. The action herein treats the claims as filed 5/2/05 and repeated 11/04/05 with arguments.

Claim Objections

2. Claim 3 is objected to because of the following informalities:
- Claim 3 line 6, "and in on it the" should be deleted.
 - Claim 5, "a portion of the character" should be replaced by --a portion of the layer--. The character is not believed to be transparent, but rather the area surrounding the character.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-9, 21, 23-28, 34-40, 46, 48-52, 58-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Goodman (Dynamic HTML).**

Regarding claims 1-5, 9, 23-27, 34-36, 40, 48, 49, 58, 59, 63-66, Gever et al (WO 97/35280) teaches the steps, system and programming to provide an animated character travel (translationally) across the user's screen in the form of an advertisement [abstract, 4:5-11, 7:1-15, 32:29-3136:11-13, figs 2, 6A]. The character is provided intrusively, out of the user's control as a transparent layer on top of the background content (such as a web page in an HTML-compliant browser application program). The area not covered by the character layer is visible through the transparency mask [7:10-17, 26:6-31]. Gever et al (WO 97/35280) teaches that the character may include audio such as reading displayed text (synchronized sound) – such is taken to provide a multimedia character [7:8-10]. Applicant's preamble and other language that mentions the environment of the operating system, computer system, application program and language, etc does not positively provide steps to be taken or system structure and therefore these are not taken as positive limitations. The environment in which a series of steps are performed does not define the steps themselves, for example. While Gever et al (WO 97/35280) does teach the use of a specialized (i.e. dedicated) scene manager, he also discloses other means for providing the animation. Gever et al (WO 97/35280) teaches that the animation files can be provided as VMRL, JAVA or HTML or in another standard file format recognized by suitable browsers [3:1-15, 10: 1-5,]. Gever et al's (WO 97/35280) teaching that the animation can be provided via HTML (or in another standard file format recognized by suitable browsers) is an indication that no specialized or dedicated code need be present before introduction; the animation can be provided by these general purpose browser capabilities. Gever et al (WO 97/35280) states that the animation is provided as a layer *on top of the browser window* [7:10-12, 4:14-16] rather than *in the browser window* as

applicant's claims require. While the use of an HTML-capable or VRML-capable or JAVA-capable browser likely provides this layer as an uppermost layer within the browser (remember these embodiments not requiring a specialized scene manager provide animation capabilities by the browser program itself which does control the browser window), Gever et al (WO 97/35280) nonetheless says "over" rather than "in". Goodman (Dynamic HTML) teaches an operating system and programming feature which enables multiple layers *within* a single browser application window. The use of DHTML and a <layer> tag enables a programmer to provide "dynamic addition of new content" in an upper layer of a web page having independent layers, all within the same browser application window. This can even be accomplished independently, after an initial page layer has been created. It would have been obvious to one of ordinary skill at the time of the invention to have provided the animation of Gever et al (WO 97/35280) as a layer *within* the browser window rather than simple *over* the browser window so that the animation is rendered with the browser window. This would allow a user to resize and move the browser around his desktop without removing or disassociating the animation layer.

Regarding claims 6-8, 28, 37-39, 46, 50-52, 60-62, Gever et al (WO 97/35280) teaches that the characters are defined as smart objects which are defined by parameters that determine their behavior; such stored parameters are taken to be stored in a server-accessible database [5:29-37, 6:1-17]. The client's PC communicates with the server in order to request and negotiate/authorize display of the animations. This communication is taken to meet the "exchange of information" language. The client PC inherently cannot display/control the animation if the PC lacks a minimum of video display capabilities, for

example. The communication/exchange is taken to be interactive and results in determination of a sequence of commands to deliver that control the animation aspects.

Regarding claim 21, Gever et al (WO 97/35280) teaches that a sender may deliver an email message with an animation file included [10:23-27]. The animation files define the character behavior. The server signal which will call a page language does not provide any positive steps beyond a signal. Steps for calling of a page and displaying after completion of the message are not set forth positively. Nonetheless, the server which delivers the email inherently defines a background in the case of an HTML-based email message which remains until the user closes the message.

5. Claims 10-12, 14-20, 29-33, 41-45, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Goodman (Dynamic HTML) and Gever et al (US6313835).

Regarding claims 10, 12, 14-18, 29-32, 41-45, Gever et al (US6313835) teaches that such animations can be programmed by an advertiser and triggered to display upon the user visiting a particular webpage. An animation ad is then chosen for the user based upon the user's profile and delivered and displayed for the user in his browser. It would have been obvious to one of ordinary skill at the time of the invention to have provided tags in particular webpages that enabled the system to recognize an advertising opportunity and to trigger the selection, delivery and display of the animation advertising character. The example of a user browsing Yahoo [WO fig 6A] while receiving an animation provides an example of content from a content server and animation from the system server of Gever et al (WO 97/35280).

Regarding claims 11, 33, Gever et al (WO 97/35280) teaches that the animation display capability can be provided as part of a general purpose browser plug-in such as the cosmo player for VRML purposes [3:13]. It would have been obvious to one of ordinary skill at the time of the invention to have delivered the animation file as well as the plug-in installation file so the user can view the animation upon installation of the plug-in.

Regarding claims 19, 20, 47, Official Notice is taken that it is well known to use cookies to track and deliver user profile information, browsing history and preferences, etc and it would have been obvious to one of ordinary skill at the time of the invention to have used such cookies to target the animation selection and control of Gever et al (WO 97/35280).

6. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Goodman (Dynamic HTML), Gever et al (US6313835) and Middleton et al (WO 99/13423).** Middleton et al teaches tracking the effectiveness of web advertising in terms of the number of impressions and the duration of ad display. It would have been obvious to one of ordinary skill at the time of the invention to have tracked such information and paid the advertiser provider (i.e. Gever's character server) accordingly so that the advertiser pays more for the effectiveness of the advertising.

7. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gever et al (WO 97/35280) in view of Goodman (Dynamic HTML) and Middleton et al (WO 99/13423).** Middleton et al teaches tracking the effectiveness of web advertising in terms of the number of impressions and the duration of ad display. It would have been obvious

to one of ordinary skill at the time of the invention to have tracked such information and paid the advertiser provider (i.e. Gever's character server) accordingly so that the advertiser pays more for the effectiveness of the advertising.

Response to Arguments

8. Applicant argues that Gever '280 requires an animation program (the scene manager) which serves only the purpose of the character animation. Applicant states that the instant invention provides animation through more general purpose software (FLASH, GIF) that is not "dedicated" to such character animation. However, Gever '280 also teaches alternative animation functionality being provided by HTML, VRML or JAVA which are not believed to require the specialized scene manager, but simply an HTML-capable or VRML-capable or JAVA-capable browser. These browser capabilities support general purpose programming which clearly are not dedicated simply to Gever '280's types of character animation; many other uses for these programming platforms are notoriously well known.

9. Applicant argues that claims 1, 3, 5 require modifying an image produced by an application and that the character is introduced into the image. Gever '280 provides a character animation layer superimposed upon a browser image below whereby areas covered by the character are not visible, yet areas not covered by the character remain visible. This is taken to provide modification of the presented image (i.e. it now includes a character introduced into the browser image. In fact, the instant invention is believed to *modify the image* and to introduce a character *into the image* in much the same way – via a layer.

10. Applicant's language that the character is located *in* the uppermost layer of an application program window is indeed different than the examiner's previous interpretation which erroneously defined the claim as merely requiring a character which located **on top of** the application window. Gever '280 is clearly on top of the browser window, and perhaps in a layer that forms an integral part of the browser application program window. Applicant has made arguments that a user could close the browser of Gever '280 and the animation layer of Gever '280 would continue on its own. Applicant has also argued that if a user resizes or moves the browser window, that the Gever '280 animation layer might no longer be on top of the browser window. Examiner does not necessarily agree with these supposed behaviors and believes Gever '280 to be silent on this behavior. Examiner has included a reference which teaches and renders obvious the idea of providing Gever '280's animation layer as an integral part of the browser/application window.

11. Applicant argues that Gever '280 does not provide a portion of the character as transparent. Examiner first believes that this quality is not present in the instant invention/disclosure. Nonetheless, Fig 2 and page 25 lines 22-25 teach at least partially transparent character portions.

12. Applicant again argues that a 2005 New York Times article attest to the uniqueness of floater ads – an advertising type that describes the instant invention. However, the uniqueness and desirability of such ads are also believed to describe the types of ads presented by Gever '280 as well as ads proposed by combinations using Gever '280.

13. Applicant again argues that Gever '280 teaches away from the present invention because Gever '280 gives control of the character to a user. Examiner repeats his

argument hat several disclosures in Gever '280 describe users lacking control over the animated characters.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc